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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/089,445

03/29/2002

Keith R. Preston

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EXAMINER

McFADDEN, SUSAN IRIS

ART UNIT

PAPER NUMBER

2655

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,445

Applicant(s)

PRESTON, KEITH R.

Examiner

Susan McFadden

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2655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

2. The abstract of the disclosure is objected to because it contains the word "means" and "Figure 1". Correction is required. See MPEP § 608.01(b).

Claim Objections

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claim 19 is missing. ***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claimed invention is directed to a computer program which is non-statutory.

Claim 20 is drawn to a program per se as recited in the preamble and as such is non-statutory subject material. See MPEP 2106.IV.B.1.a. Data structures not claimed as embodied in computer readable media are descriptive material per se and are not statutory because they are not capable of causing function change in the computer. See, e.g. Warmerdam, 33F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory). Such claimed data structures do not define any structural and functional interrelationships between the data structure and other claimed aspects of the invention, which permit the data structure's functionality to be realized. In contrast, a claimed computer readable medium encoded with a data structure defines structural and functional interrelationships between the data structure and computer software and hardware components which permit the data structure's functionality to be realized and is thus statutory. Similarly, computer programmed claimed as computer listing are not physical "things".

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1,8,16,17, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Katz et al. (5,404,295).

In regard to claims 1,8,16,17, and 20, Katz et al. show a system, computer program, and method of presenting information to a user in respect of a query (abstract), the method comprising the steps of: (i) decoding the query into one or more semantically meaningful query elements (abstract, Fig. 3 and col. 10, line 13 - col. 11, line 29), (ii) accessing annotation elements stored in a first data store (abstract and col. 10, line 13 - col. 11, line 29), (iii) comparing a semantically meaningful query element from step (i) with the annotation elements so as to identify at least one annotation element that matches the semantically meaningful query element (abstract and col. 10, line 13 - col. 11, line 29), (iv) retrieving a plurality of data entries corresponding to the identified annotation elements), each of the plurality being stored in a second data store (abstract and col. 10, line 13 - col. 11, line 29), and (v) presenting the plurality of retrieved data entries to the user (abstract and col. 10, line 13 - col. 11, line 29 and col. 9, lines 53-63), in which queries are received from the user via input means (Fig. 1, item 16). All the features except the characterizing part of claim 1 have already been disclosed in Katz. The objective technical problem based on Katz is how to provide a specifically ordered output of the retrieved data entries. The solution according to claim 1 is to use user preferences and discourse criteria. This solution, as well as the more specific details relating to this in the description appear to be directed to result ranking

based on a user profile for which an evolution is accomplished based on user input and feedback. Even this more specific solution is considered to be common background knowledge in the technical field at the filing date.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2-7, 9-15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Katz et al. (cited above) in view of Sheth et al. (6,311,194).

In regard to claims 2-4 and 9-10, Katz et al. shows the system and method discussed above. They do not specifically show that the preferences of the user are store as templates, which gives a default ordering for the presentation of data entries which can be monitored and stored. Sheth et al. show a system and method that shows it is common to use default ordering and templates (col. 9, ln 40-col 12). This information can be extracted, monitored and stored. It would be obvious to one of ordinary skill in the art at the time of the invention to combine these references because they can form a system that can provide a higher precision, relevant, and timely output of a search system (col. 4, ln 27-30).

In regard to claim 5 and 11, Katz et al. and Seth et al. show the system and method discussed above. They do not specifically show that the annotation elements are arranged in accordance with semantic relationships between annotation elements,

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or lexical relationships between annotation elements. The Examiner takes Official Notice that one of Ordinary Skill in the art would know that annotation elements could be arranged as determined by the designer. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to add this features because it makes the system more customizable.

In regard to claims 6 and 15, Katz et al. shows the system and method discussed above. They do not specifically show that the comparison step (iii) includes the steps of: inputting a semantically meaningful query element into a predetermined rule; inputting an annotation into the predetermined rule, and processing the rule. Sheth et al. show a system and method that can extract data according to rules (col 12). This information can be extracted, monitored and stored and the data entries can include all or any of text, hyperlinks, graphical data, pagelets, computer programs and/or video data (col. 12). It would be obvious to one of ordinary skill in the art at the time of the invention to combine these references because they can form a system that can provide a higher precision, relevant, and timely output of a search system (col. 4, ln 27-30).

In regard to claims 7 and 18, Katz et al. shows the system and method discussed above. They do not specifically show analyzing the query so as to extract: a subject of the query; a property of the query; the steps of: retrieving one or more predetermined sets of queries and responses from a further data store, each of which set has at least one property and at least one subject identifier; comparing the subject and property information extracted at step (a) with the property or properties and subject identifiers retrieved at step (b) so as to identify a predetermined set of queries and responses

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relating to the query; and automatically submitting the queries comprising the predetermined set for processing according to decoding step. Sheth et al. show a system and method that can extract data including subject and property according to queries (col 12). This information can be extracted, monitored and stored. It would be obvious to one of ordinary skill in the art at the time of the invention to combine these references because they can form a system that can provide a higher precision, relevant, and timely output of a search system (col. 4, ln 27-30).

In regard to claim 12, Katz et al. shows the system and method discussed above. They do not specifically show that the decoding means includes a linguistic store comprising lexical, syntactic and discourse information and being accessible by the decoding means for deriving semantically meaningful elements corresponding to the query. The Examiner takes Official Notice that one of Ordinary Skill in the art would know that most query systems contain a linguistic store. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to add this feature because it makes the system more customizable.


In regard to claim 13, Katz et al. shows the system and method discussed above. They do not specifically show that queries can be entered in a plurality of languages. The Examiner takes Official Notice that one of Ordinary Skill in the art would know that most query systems could contain multiple input languages. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to add this feature because it makes the system more customizable.

In regard to claim 14, Katz et al. shows the system and method discussed above. They do not specifically show linking means for linking at least one annotation to at least one data entry in the data store. The Examiner takes Official Notice that one of Ordinary Skill in the art would know that how to link annotation data. Therefore, it would be obvious to one of ordinary skill in the art at the time of the invention to add this feature because it makes the system more customizable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan McFadden whose telephone number is 571-272-7621. The examiner can normally be reached on Monday-Friday, 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571-272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Susan McFadden
Primary Examiner
Art Unit 2655

November 3, 2005